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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,629	10/18/2001	Kenneth F. Buechler	071949-1315	8727
30542	7590	04/19/2004	EXAMINER	
FOLEY & LARDNER P.O. BOX 80278 SAN DIEGO, CA 92138-0278			ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/982,629	Applicant(s) BUECHLER, KENNETH F.	
	Examiner Lyle A Alexander	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/9/04 interview summary.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This Office action is in response to the 4/9/04 interview summary and a further search that found new art relevant to the instant claims. This non-final Office action will replace the 1/14/04 final rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kuhn et al.

See the appropriate paragraph of paper 9.

Kuhn et al. further teaches predetermined liquid flow paths that lead the sample to the reagent area. In column 4 lines 40+ specifically describe the sample is prevented

from laterally moving from the sample-receiving site by impermeable barrier means.

These impermeable barrier means have been read on the claimed channels.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Romanauskas.

Romanauskas et al. teach a device with a hydrophilic capillary fluid inlet and a hydrophobic capillary outlet to control fluid flow characteristics (see the abstract). This has been read on the claimed fluid flow through a first capillary hydrophilic region to a second adjacent hydrophobic region. Column 2 lines 58+ through column 4 teach three capillary channels(44,45 and 46) and specifically hydrophobic capillary(44) channel and hydrophilic capillaries(45 and 46) that have been read on the claimed first hydrophilic, second hydrophobic and the third hydrophilic capillary regions. Air is expelled through outlet capillary(44) that has been read on the claimed vent.

Response to Arguments


Applicant's arguments filed 10/22/03 have been fully considered but they are not persuasive.

Applicants argue Kuhn et al. does not teach the claimed capillary channel but rather teaches capillary flow through a bibulous substrate. Applicants have references page 5 lines 3+ of the specification that "the devices described herein do not use bibulous or porous materials " as well as the 10/21/03 1.132 Declaration to bolster their position the bibulous capillary flow of Kuhn et al. cannot be read on the instant claims. Applicant concludes the aforementioned definitions define the claimed capillary channel that

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defines over Kuhn et al. The capillary channel is claimed as "comprising a capillary region" and is indistinguishable from the taught capillary regions in the bibulous substrate of Kuhn et al. The claimed capillary channels must be interpreted in light of the specification (e.g. in view of a positive definition of the capillary channels). Upon further review of the specification, no description of the claimed capillary channel could be found that would exclude the capillary flow regions found in bibulous materials. In the absence of the specification providing a positive description of what a capillary channel is, it is insufficient for Applicant to pick a definition from the specification of what the capillary channel is not or use a 1.132 Declaration to define the term superceding the specification especially when the "capillary channel" is claimed in terms indistinguishable from Kuhn et al. (e.g. "comprising a capillary region"). The Office respectfully maintains the rejection over Kuhn et al. is proper. Applicant is encouraged to further review the specification for a positive definition describing the claimed capillary channel in such terms to define over Kuhn et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


LYLE A. ALEXANDER
PRIMARY EXAMINER
GROUP 1300